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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/841,038
Filing Date: April 25, 2001
Appellant(s): MORITA, FUJIO

MAILED

JUL 13 2007

Technology Center 2100

Luminita A. Todor
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/03/2007 appealing from the Office action mailed 8/10/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

JP 10031683

Kurosawa Haruhiro

3-1998

Related Art - Specification pages 1-5, up to line 2 & Figures 1, 2A & 2B.

(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Related Art "specification pages 1-5, up to lines 2 and Figs 1, 2(A-D) and 3(A-B)" ("Related Art") in view of U.S. JP No. 10031683A issued to Kurosawa Haruhiro ("Haruhiro").

As per claim 1, Related Art discloses "implemented in a client computer a search unit that determines a hierarchical category of an address designated for registration based on a definition entry and a selection record of a menu" (i.e., three search engines and categorized (hierarchical) type, see figure 1, page 2, lines 26-32); and

"a registration unit that registers an address in the category" (i.e., list registered bookmarks; see Figs 1-3A, element S 16, page 3, line 30 to page 4, line 19),

"wherein predefined search information is registered for each category" (see page 4, lines 31-34),

"wherein, when a new keyword is search for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword" (see page 2, line 18-33), and "registers the lower level category in a manner to be linked to an upper level

category" (i.e., bookmark is registered, so that the homepage can be promptly accessed by simply selecting the URL address from a list of registered bookmark; see page 2, lines 18-25).

Related Art fails to explicitly disclose a search support device in which an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network. However, Haruhiro discloses a search support device, the device comprising: an address indicating a location of information accessible on a network is registered; and which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network (see page 17, paragraph [0040]). It would have been obvious to a person of ordinary skill in the art to modify the teachings of Related Art with a search support device, the device comprising: an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the teachings of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of World Wide Web servers connected to a W W W (see Haruhiro abstract).

As per claim 2, Related Art discloses "wherein the registration unit registers the address designated for registration in the category containing the registered address the registered address when located at the same level as the address designated for registration" (see page 2, line 18-33).

As per claim 3, in addition to claim 1, Related Art discloses "determining a category of an address designated for registration based on a definition entry and a selection record of a menu" (see page 4, line 11 to page 5, line 2).

As per claim 4, in addition to claim 1, Related Art discloses "a category menu storage unit that stores a category menu in which predetermined categories are listed up" (i.e., the information including

the URL address of each registered homepage is registered as the list of registered bookmarks; see figure 3, page 4, lines 15-19).

As per claim 5, in addition to claims 1 and 3, Related Art further discloses "a display unit that displays an address in another form indicating the location of desired information detected based on the search information generated by the search information generating unit" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 6, Related Art further discloses "an address selection unit that selects the address registered in the category menu so as to make an access to the location of the desired information" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 7, Related Art discloses "an icon conversion unit that visually changes the category in which the address is registered by the address registration unit" (see figures 2 and 3, page 2, line 26 to page 3, line 22).

As per claim 8, in addition to claim 1, Related Art discloses "storing a category menu in which predetermined categories are listed up" (i.e., the information including the URL address of each registered homepage is registered as the list of registered bookmarks; see figure 3, page 4, lines 15-19).

As per claim 9, in addition to claim 1, Related Art discloses "a recording medium which stores a program for a computer to perform an operation" (see Figs. 1 to 3B, page 2, lines 26-33),

"a procedure for classifying the address in accordance with a category related to information that can be accessed at the address" (see page 4, line 11 to page 5, line 2); and

"a procedure for registering the address classified in accordance with the category" (i.e., using a search engine to obtain desired information, and categorized (hierarchical) type, see page 1, lines 27-34).

As per claim 10, in addition to claim 1, Related Art discloses "a recording medium which stores a program for a computer to perform an operation" (see Figs. 1 to 3B, page 2, lines 26-33),

"a procedure for generating search information associated with a category selected from the category menu" as the information including the URL address of each registered homepage is registered as the list of registered bookmarks, (see figure 3, page 4, lines 15-19); and

"a procedure for registering the address classified in accordance with the category" (see Figs 1-3A, element S 16, page 3, line 30 to page 4, line 19).

As per claim 11, Related Art discloses "wherein the program further includes a procedure for generating the category menu" (see Figs. 3(A and B)).

As per claim 12, Related Art discloses "a method, implemented in a client computer" (see page 1, line 35 to page 2, line 1), the method comprising:

"a searching for the address of the desired information based on the registered predetermined search information when hierarchical category is selected" (i.e., using a search engine to obtain desired information, and categorized (hierarchical) type, see page 1, lines 27-34); and

"wherein, when a new keyword is search for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword" (see page 2, line 18-33), and "registers the lower level category in a manner to be linked to an upper level category" (i.e., bookmark is registered, so that the homepage can be promptly accessed by simply selecting the URL address from a list of registered bookmark; see page 2, lines 18-25).

Related Art fails to explicitly disclose for searching for an address of desired information on a network based on search information associated with the desired information; which registering predetermined search information on the network for each of a plurality of hierarchical categories into which information is classified. However, Haruhiro discloses for searching for an address of desired

information on a network based on search information associated with the desired information; which registering predetermined search information on the network for each of a plurality of hierarchical categories into which information is classified (see Haruhiro page 17, paragraph [0040]). It would have been obvious to a person of ordinary skill in the art to modify the teachings of Related Art with for searching for an address of desired information on a network based on search information associated with the desired information; which registering predetermined search information on the network for each of a plurality of hierarchical categories into which information is classified as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the teachings of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of world wide web servers connected to a W W W (see Haruhiro abstract).

(10) Response to Argument

The Examiner will address the arguments in the order submitted by the appellant(s).

Argument:

Appellant stated, page 7, paragraph 1 to page 8, paragraph 3, (A) Applicants respectfully submit that FIG. 1, the indicated paragraph and the entire "Background Art" section do not disclose the search unit as recited in claim 1 at least because there is no teaching or suggestion of "a hierarchical category of an address [...] based on a definition entry and a selection record of a menu."

(B) Combining the teaching from the "Background Art" section of the specification with Haruhiro's teachings is unjustified and does not amount to teaching or disclosing all the features of claim 1. As an alleged motivation, the Office Action mailed on August 10, 2006, states on page 3:

Response:

It is noted that Related Art discloses search engines and categorized (hierarchical), as a result of the search process, a plurality of titles of homepages displayed as shown in Figure 2B; see page 2, line 34 to page 3, line 6.

Further, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Haruhiro discloses a search support device, the device comprising an address indicating a location of information accessible on a network is registered; and which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network (see page 17, paragraph [0040]). It would have been obvious to a person of ordinary skill in the art to modify the method Related Art by a search support device, the device comprising an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the method of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of World Wide Web servers connected to a W W W (see Haruhiro abstract), therefore, improving the reliability of the search support device and method, and recording medium storing program for computer to carry out operation with said search support device.

Therefore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, Related Art discloses three types of search engines, first a keyword-inputting type; second categorized type, and third keyword-inputting and categorized type.

Haruhiro discloses a retrieval server (Fig.1) is accessible to servers and it collects URL information of all servers; see page 17, [0038]. Thus, the combination of Related Art and Haruhiro discloses the claimed invention.

Argument:

Appellant stated, page 9, paragraph 6 to page 10, paragraph 3, (section B.) As per claim 3, the applied prior art fails to teach or suggest at least: "determining a hierarchical category of an address designated for registration based on a definition entry and a selection record of a menu"; and "registering an address in the hierarchal category, wherein predetermined search information is registered for each category, which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network," and "when a new keyword is searched for by using combination of a plurality of upper level keywords, a registration unit generates a lower level category corresponding to the new keyword, and registers the lower level category in a manner to be linked to an upper level category" (emphasis ours).

Response:

It is noted that, the limitations of claim 3 are similar to claim 1, therefore, in addition to claim 1, Related Art further discloses "determining a category of an address designated for registration based on a definition entry and a selection record of a menu" (see page 4, line 11 to page 5, line 2). Furthermore, Related Art discloses "determining **a hierarchical category** of an address designated for registration based on a definition entry and a selection record of a menu" (i.e., search engines and categorized (hierarchical) type, see figure 1, page 2, lines 26-32); and "**registering an address in the hierarchal category**, wherein predetermined search information is registered for each category, which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network" (i.e., list registered bookmarks; see Figs 1-3A, element S 16, page 3, line 30 to page 4, line 19); and

"when a new keyword is searched for by using combination of a plurality of upper level keywords" (see page 2, line 18-33), and "registration unit generates a lower level category corresponding to the new keyword, and registers the lower level category in a manner to be linked to an upper level category" (i.e., bookmark is registered, so that the homepage can be promptly accessed by simply selecting the URL address from a list of registered bookmark; see page 2, lines 18-25).

Argument:

Appellant stated, page 10, paragraph 4 to page 11, paragraph 3 (section C.), As per claim 8, the applied prior art fails to teach or suggest at least: "storing a category menu in which predetermined **hierarchical** categories are listed up;" and "generating search information associated with a **hierarchical** category selected from the category menu," "predetermined search information is registered for each category, which predetermined search information is used as a **keyword for searching for the address** indicating a location of desired information accessible on the network," and "when a new keyword is searched for by using a combination of a plurality of upper level keywords, a registration unit generates a lower level category corresponding to the new keyword, and registers the lower level category in a manner to **be linked to an upper level category.**"

Response:

It is noted that, in addition to claim 1, Related further Art "storing a category menu in which predetermined **hierarchical** categories are listed up" (i.e., search engines and categorized (hierarchical) type, see figure 1, page 2, lines 26-32) and "generating search information associated with a **hierarchical** category selected from the category menu" (i.e., bookmark is registered, so that the homepage can be promptly accessed by simply selecting the URL address from a list of registered bookmark; see page 2, lines 18-25). Related Art fails to explicitly disclose predetermined search information is registered for each category, which predetermined search information is used as a **keyword for searching for the address** indicating a location of desired information accessible on the network. However, Haruhiro discloses predetermined search information is registered for each category, which predetermined search

information is used as a **keyword for searching for the address** indicating a location of desired information accessible on the network (see Haruhiro page 17, paragraph [0040]). It would have been obvious to a person of ordinary skill in the art to modify the teachings of Related Art by predetermined search information is registered for each category, which predetermined search information is used as a **keyword for searching for the address** indicating a location of desired information accessible on the network as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the method of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of world wide web servers connected to a W W W (see Haruhiro abstract), therefore, improving the reliability of the search support device and method, and recording medium storing program for computer to carry out operation with said search support device.

Argument:

Appellant stated, page 12, paragraph 4 (section B.). Claim 1 is directed to a device, while claims 9 and 10 are directed to a "recording medium which stores a program for a computer to perform an operation with a search support device, implemented on a client computer, that registered an address indicating a location of accessible information on a network." It is inappropriate and self-serving to ignore all the particular recitations in claims 9 and 10, which are different from claim 1, particularly when on page 8 of the same Office Action, Applicant's arguments for patentability of claims 3, 4, 8-10 and 12 are disregarded because of different recitations. Further, the Office Action fails to put forth a prima facie case of obviousness as required by 37 C.F.R. §1.104(c).

Response:

In response to appellant's argument that "the Office Action fails to put forth a prima facie case of obviousness as required by 37 C.E.R. §1.104(c)." The examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, Haruhiro discloses a search support device, the device comprising an address indicating a location of information accessible on a network is registered; and which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network (see page 17, paragraph [0040]). It would have been obvious to a person of ordinary skill in the art to modify the teachings of Related Art with a search support device, the device comprising an address indicating a location of information accessible on a network is registered; which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network as disclosed by Haruhiro (see Haruhiro Figs. 1 and 4 and corresponding paragraphs). Such a modification would allow the method of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of World Wide Web servers connected to a W W W (see Haruhiro abstract), therefore, improving the reliability of the search support device and method, and recording medium storing program for computer to carry out operation with said search support device.

Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the

claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

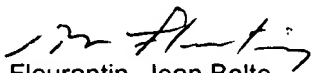
The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Fleurantin, Jean Bolte

Patent Examiner

Technology Center 2100

Conferees:



Breene, John E.

Supervisory Patent Examiner

Technology Center 2100




HOSAIN ALAM
SUPERVISORY PATENT EXAMINER

Cottingham, John R.

Supervisory Patent Examiner

Technology Center 2100


JOHN COTTINGHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

July 02, 2007

Luminita A. Todor

1201 New York Avenue, NW, 7th Floor

Washington, DC, 20005